

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Berez et al.

Application No.: 10/724,010

Group No.: 3733

Filed: November 25, 2003

Examiner: Philogene, P.

For: Patient Selectable Joint Arthroplasty Devices and Surgical Tools Facilitating Increased Accuracy, Speed and Simplicity in Performing Total and Partial Joint Arthroplasty

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**TRANSMITTAL OF SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
BEFORE MAILING DATE OF EITHER A FINAL ACTION
OR NOTICE OF ALLOWANCE (37 C.F.R. § 1.97(c))**

**TIME OF TRANSMITTAL OF ACCOMPANYING
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

1. The information disclosure statement transmitted herewith is being filed *after* three months of the filing date of this national application or the date of entry of the national stage as set forth in Section 1.491 in an international application or after the mailing date of the first Office action on the merits, whichever event occurred last but *before* the mailing date of either

(1) a final action under § 1.113 or

(2) a notice of allowance under § 1.311

whichever occurs first.

FEE

2. Accompanying this transmittal is the fee for submission of an information disclosure statement under section 1.97(c). (\$180.00)

FEE PAYMENT

3. Applicant elects the option to pay the fee set forth in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under § 1.97(c) (\$180.00).

Fee due \$180.00

METHOD OF PAYMENT OF FEE

4. Authorization is hereby made to charge the amount of \$180.00 to Deposit Account No. 19-4972.
- Charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 19-4972.

DATE: September 4, 2009

/Alexander J. Smolenski, Jr., #47,953/

Alexander J. Smolenski, Jr.
SUNSTEIN KANN MURPHY & TIMBERS LLP
Customer Number 02101
125 Summer Street
Boston, MA 02110-1618
US

02960/00116 1140761.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Berez et al.

Application No.: 10/724,010

Group No.: 3733

Filed: November 25, 2003

Examiner: Philogene, P.

For: Patient Selectable Joint Arthroplasty Devices and Surgical Tools Facilitating Increased Accuracy, Speed and Simplicity in Performing Total and Partial Joint Arthroplasty

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant:

(1) Within three months of the filing date of a national application;

(2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or

(3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

NOTE: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) each inventor named in the application;

(2) each attorney or agent who prepares or prosecutes the application; and

(3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).

NOTE: The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.

WARNING: *"No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).*

List of Sections Forming Part of This Supplemental Information Disclosure Statement

The following sections are being submitted for this Supplemental Information Disclosure Statement:

(check sections forming a part of this statement: discard unused sections and number pages consecutively)

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☐ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☐ Concise Explanation of Non-English Language Listed Information Items
 - 7A. ☐ EPO Search Report
 - 7B. ☐ English Language Version of EPO Search Report
8. ☐ Translation(s) of Non-English Language Documents
9. ☐ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

(complete the following, if appropriate)

Sections _____, respectively, have been continued on ADDED PAGE(S).

NOTE : "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

Section 1. Preliminary statements

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Berez et al. Attorney Docket: 2960/116

Serial No: 10/724,010 Art Group Unit: 3733

Date Filed: November 25, 2003 Examiner Name: Philogene, P.

Invention: Patient Selectable Joint Arthroplasty Devices and Surgical Tools Facilitating Increased Accuracy, Speed and Simplicity in Performing Total and Partial Joint Arthroplasty

**LIST OF PATENTS AND PUBLICATIONS FOR
APPLICANT'S SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
/P.P./	ES	US 4,586,494	May 6, 1986	Keller	128/92E
/P.P./	ET	US 4,601,290	Jul. 22, 1986	Effron et al.	128/305
/P.P./	EU	US 5,503,162	Apr. 2, 1996	Athanasίου et al.	128/774
/P.P./	EV	US 5,728,162	Mar. 17, 1998	Eckhoff	623/20
/P.P./	EW	US 6,916,341	Jul. 12, 2005	Rolston	623/20.3

U.S. PATENT PUBLICATION DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
/P.P./	EX	US 2002/0183850	Dec. 5, 2002	Felt et al.	623/20.16
/P.P./	EY	US 2003/0158606	Aug. 21, 2003	Coon et al.	623/20.15
/P.P./	EZ	US 2003/0225457	Dec. 4, 2003	Justin et al.	623/20.14
/P.P./	FA	US 2004/0133276	Jul. 8, 2004	Lang et al.	623/14.12
/P.P./	FB	US 2004/0138754	Jul. 15, 2004	Lang et al.	623/20.14
/P.P./	FC	US 2004/0147927	Jul. 29, 2004	Tsougarakis et al.	606/53
/P.P./	FD	US 2004/0153079	Aug. 5, 2004	Tsougarakis et al.	606/77
/P.P./	FE	US 2004/0167630	Aug. 26, 2004	Rolston	623/20.14
/P.P./	FF	US 2004/0204760	Oct. 14, 2004	Fitz et al.	623/14.12
/P.P./	FG	US 2004/0204644	Oct. 14, 2004	Tsougarakis et al.	600/410
/P.P./	FH	US 2005/0267584	Dec. 1, 2005	Burdulis et al.	623/20.19
/P.P./	FI	US 2009/0131941	May 21, 2009	Park et al.	606/87

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
/P.P./	FJ	WO	00/059411	Oct. 12, 2000	Fell et al.	A61F 2/38
/P.P./	FK	WO	04/049981	Jun. 17, 2004	Imaging Therapeutics, Inc.	A61F 2/46

Applicants: Berez et al. Attorney Docket: 2960/116
 Serial No: 10/724,010 Art Group Unit: 3733
 Date Filed: November 25, 2003 Examiner Name: Philogene, P.
 Invention: Patient Selectable Joint Arthroplasty Devices and Surgical Tools Facilitating Increased Accuracy, Speed and Simplicity in Performing Total and Partial Joint Arthroplasty

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
/P.P./	FL	WO	06/060795	Jun. 8, 2006	ConforMIS, Inc.	A61B 17/17

Examiner Signature: /Pedro Philogene/

Date Considered: 09/15/2009

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

Section 6. Copies of Listed Information Items Accompanying This Statement

NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (i) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . ."

NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

(complete the following, if applicable)

☒ Exception(s) to above:

Copies of cited U.S. patents and U.S. patent application publications are not included, as the Office has not required them.

Copies of cited pending unpublished U.S. applications that are available in the USPTO's IFW system are not included. See *Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications*, 1287 O.G. 163 (Oct. 19, 2004).

☐ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

☐ Cumulative patents or publications identified in Section 5.

Section 10. Identification of Person(s) Making This Information Disclosure Statement

The person making this certification is

(check each applicable item)

- (a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

- (b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

- (c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.

Reg. No.: 47,953

Tel. No.: (617) 443-9292

Customer No.: 02101

02960/00116 1140406.1

/Alexander J. Smolenski, Jr., #47,953/

SIGNATURE OF PRACTITIONER

Alexander J. Smolenski, Jr.

(type or print name of practitioner)

125 Summer Street, 11th Floor

P.O. Address

Boston, MA 02110-1618